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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/765,491	01/18/2001	Jack L. Arbiser	EU 98055 CON	8772

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EXAMINER	
KIM, JENNIFER M	

ART UNIT	PAPER NUMBER
1617	

DATE MAILED: 02/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	**Application No.** 09/765,491	**Applicant(s)** ARBISER, JACK L.	
	Examiner Jennifer Kim	**Art Unit** 1617	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 28 October 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a) ☐ The period for reply expires _____months from the mailing date of the final rejection.
   b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): 35 U.S.C. 112, first paragrph.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: *4-6,10-12 and 17-19*.
   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☒ Other: See Continuation Sheet.

SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER

Continuation of 11. does NOT place the application in condition for allowance because: The claimed subject matter is deemed to fail to patentably distinguish over the state of the art as represented by the cited references. With regard to 35 U.S.C. 102 rejection: Applicant argues Wirostko describes systemic administration of tetracycline to treat acne rosacea which is different than rosacea. This is not persuasive because Applicant's claimed disease "Rosacea" is originally termed "acne rosacea" which is a chronic inflammatory skin condition affecting the face and eyelids of certain middle-aged adults presenting clinical singed including erythema (redness), dryness, papules, pustules and nodules either singly or in combination in the involved skin areas. (See attached PTO-892, McDaniel, U.S Patent No. 5952372A, column 1, lines 12-35). Accordingly, Wirostko teaches same active agent (tetracyclines having collagenase inhibition properties) utilized to treat same disorder and the rejection is deemed proper. With regard to 35 U.S.C.103 rejection: Applicant argues there is nothing that would lead one skilled in the art of treating lymphangiogenesis to adopt the peculiar description of Deutch and combined it with Brem et al. or Teicher with any expectation of success. This is not persuasive because Deutch et al. teach that angiogenesis activity is defined as the ability to inhibit or enhance the formation of blood vessels or lymph vessels. It is clear that lymphangiogenesis is the formation of lymphatic vessels from lymphatic vessels of angiogenesis. Therefore, there is direct correlation of lymphangiogenesis within angiogenesis which would motivate one of ordinary skill in the art employ angiogenesis inhibitor such as minocycline or TNP-470 for the treatment of lymphangiogenesis which shares same biological mechanism of involving enhance formation of blood vessels (angiogenesis) within the lymph vessels. Applicant argues that it is difficult to understand how the use of this formulation could be obvious since the same examiner previously allowed claims to the composition per se, in the now issued parent application, U.S.Patent No. 6,673,843. This is not persuasive because the compositions to be utilized in instant claims differ since it is broader. It is noted that the patented composition is drawn to more specific "unsaturated curcuminoids". Applicants argue that the reference is using hugely different amount of drug (1mcg-100mg) as compared to the amount in the claimed formulation. This is not persuasive because the obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. In this case, there is teaching from Aggarwal that the effective dose of curcumin and curcumin analogues are administered in a dose from about 1 mcg to about 100mg. Therefore it would have been obvious to one of ordinary skill in the art to employ the amount within the effective range taught by Aggarwal in topical ointment formulation with a reasonable expectation of success in treatment of malignant melanoma with effective amounts well taught by Aggarwal. Thus, the claims fail to patentably distinguish over the state of the art as represented by the cited references..

Continuation of 13. Other:
Appeal Brief under the rules set forth in 37 CFR 1 .192(c) on November 30, 2005 is defective because the rules under 35 U.S.C. 1 .192(c) were abolished on September 13, 2004, and replaced by 37 CFR 41 .37(c), which states.

(c)(1) The brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(i) through (c)(1)(x) of this section, except that a brief filed by an appellant who is not represented by a registered practitioner need only substantially comply with paragraphs (c)(1)(i) through (c)(1)(iv) and (c)(1)(vii) through (c)(1)(x) of this section:

(i) Real party in interest. A statement identifying by name the real party in interest.

(ii) Related appeals and interferences. A statement identifying by application, patent, appeal or interference number all other prior and pending appeals, interferences or judicial proceedings known to appellant, the appellant's legal representative, or assignee which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal. Copies of any decisions rendered by a court or the Board in any proceeding identified under this paragraph must be included in an appendix as required by paragraph (c)(1)(x) of this section.

(iii) Status of claims. A statement of the status of all the claims in the proceeding (e.g., rejected, allowed or confirmed, withdrawn, objected to, canceled) and an identification of those claims that are being appealed.

(iv) Status of amendments. A statement of the status of any amendment filed subsequent to final rejection.

(v) Summary of claimed subject matter. A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under

the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 1 12, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

(vi) Grounds of rejection to be reviewed on appeal. A concise statement of each ground of rejection presented for review.

(vii) Argument. The contentions of appellant with respect to each ground of rejection presented for review in paragraph (c)(1)(vi) of this section, and the basis therefor, with citations of the statutes, regulations, authorities, and pads of the record relied on. Any arguments or authorities not included in the brief or a reply brief filed pursuant to j 41.41 will be refused consideration by the Board, unless good cause is shown. Each ground of rejection must be treated under a separate heading. For each ground of rejection applying to two or more claims, the claims may be argued separately or as a group. When multiple claims subject to the same ground of rejection are argued as a group by appellant, the Board may select a single claim from the group of claims that are argued together to decide the appeal with respect to the group of claims as to the ground of rejection on the basis of the selected claim alone. Notwithstanding any other provision of this paragraph, the failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately. Any claim argued separately should be placed under a subheading identifying the claim by number. Claims argued as a group should be placed under a subheading identifying the claims by number. A statement which merely points out what a claim recites will not be considered an argument for patentability of the claim.

(viii) Claims appendix. An appendix containing a copy of the claims involved in the appeal.

(ix) Evidence appendix. An appendix containing copies of any evidence submitted pursuant to 1.130, 1.131, or 1.132 of

this title or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted in the brief. See 41.33 for treatment of evidence submitted after appeal. This appendix may also include copies of the evidence relied upon by the examiner as to grounds of rejection to be reviewed on appeal.

(x) Related proceedings appendix. An appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of this section.

(2) A brief shall not include any new or non-admitted amendment, or any new or non-admitted affidavit or other evidence. See 1.1 16 of this title for amendments, affidavits or other evidence filed after final action but before or on the same date of filing an appeal and 41.33 for amendments, affidavits or other evidence filed after the date of the appeal.

(d) If a brief is filed which does not comply with all the requirements of paragraph.(c) of this section, appellant will be notified of the reasons for non-compliance and given a time period within which to file an amended brief. If appellant does not file an amended brief within the set time period, or files an amended brief which does not overcome all the reasons for non-compliance stated in the notification, the appeal will stand dismissed.

A review of the application reveals that the following sections are missing from the Appeal Brief:

(1) "Evidence appendix," as set forth in 37 CFR 41.37(c)(1)(ix); and
(2) "Related proceedings appendix," as set forth in 37 CFR 41 .37(c)(1)(x).
Accordingly, the Appeal Brief filed on November 30, 2005 does not comply with the new rules under 37 CFR 41.37(c). It is required that a substitute Appeal Brief be submitted that is in compliance with 37 CFR 41.37(c). For more information on the Board's new rules, please see the web page entitled "More Information on the Rules of Practice Before the BPAI," Final Rule at:

http://www.uspto.gov/web/offices/dcom/bpai/fr2004/moreinfo.html .